

November 13, 2007

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**BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: RONALD JOHN ROSENBERGER  
Application No.: 10/822,049 Art. Unit: 1733  
Filing Date: 04/10/2004 Examiner: Steven D. Maki

**Title: SCENTED TIRES**

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November 13, 2007

(Date of Deposit)

**Ronald J. Rosenberger**

(Name of applicant, assignee, or Registered Representative)

(Signature)

November 13, 2007

(Date of Signature)

**Commissioner for Patents**

P. O. Box: 1450

Alexandria, VA 22313-1450

**Attn: MAIL STOP APPEAL****REQUEST FOR RECONSIDERATION TO REMAND APPLICATION IN  
VIEW OF EXAMINER'S:**

- (1) **MAKING NEW GROUNDS OF REJECTION UNDER FINAL OFFICE ACTION:**
- (2) **FAILURE TO REMOVE NON-FINAL STATUS OF OFFICE ACTION WITH NEW GROUNDS OF REJECTION;**
- (3) **FAILURE TO ENTER AMENDMENT IN RESPONSE TO NEW GROUNDS OF REJECTION**
- (4) **FAILURE TO ALLOW ENTRY OF RESPONSE TO NEW GROUNDS OF REJECTION ON APPEAL; AND**
- (5) **ASSERTING THAT FAILURE TO ALLOW ENTRY OF RESPONSE TO NEW GROUNDS OF REJECTION ON APPEAL CONSTITUTES APPELLANT'S ADMISSION OF UNPATENTABILITY OF APPEALED CLAIMS**

Dear Sir:

Applicant-Appellant files this Request for Reconsideration, based on the following remarks, in conjunction with the response to the Notice of Non-Compliant Appeal Brief, mailed October 16, 2007, which is submitted herewith, in conjunction with the submitted and timely Notice of Appeal filed on December 8, 2006 and Brief on Appeal, filed February 8, 2007, Applicant-Appellant submits the following Corrected Brief on Appeal under 37 CFR 41.37, now due November 16, 2007, in response to the Notice of Non-Compliant Appeal Brief, mailed October 16, 2007.

**REMARKS**

Appellant-Applicant requests reconsideration by the Board of Appeals to have the pending appeal remanded to the Examiner for one or all of the following bases:

- (1) making new grounds of rejection under 102(b) and 103(b) using newly cited art (GB2,243,584) in the Final Office Action dated September 8, 2006,
- (2) failing to withdraw the finality of the Final Office Action as requested by Appellant on page 5 of the Amendment and Response filed December 8, 2006, and
- (3) failing to enter the Amendment and Response, dated December 8, 2006, including amendments to the claims and new arguments to address the new grounds of rejection; and
- (4) on Appeal, failing to allow or enter arguments in response to address the new grounds of rejection;
- (5) on Appeal, by Examiner's failing to allow or enter arguments in response to address the new grounds of rejection, the Examiner characterizes such failed entry as amounting to an admission by Appellant that the claims presented before the new grounds of rejection in the final office action lack novelty and obviousness under the new grounds of rejection.

In the Notice of Non-Compliant Amendment Appeal Brief, dated October 16, 2007, in the pending Appeal, the Examiner has requested "corrections" to the Appeal Brief by Applicant-Appellant arguing that since some arguments were presented that were made

to a new ground of rejection in the after final Response filed December 8, 2006, but not entered by the Examiner, and such arguments made in Appeal Brief are not Admissible.

However, the Examiner fails to point out or acknowledge that, since the Examiner made new made grounds of rejection in the Final Office Action dated September 8, 2006 over newly cited reference GB 2,243,584 under 102(b) and 103(a) of pending claims 1, 4-10, 12-13 and 16-17, which constituted a new ground of rejection first presented by the Examiner in the Final Office Action, Applicant did not have any other opportunity to present any claim amendments or arguments to those new rejections until the Appeal Brief. This is because the Examiner failed to allow entry of the Response filed December 8, 2006.

Accordingly, if the Examiner made new rejections in the Final Office Action, did not remove the finality of the Final Office Action, and then did not enter Appellant-Applicant's claim amendments and response to those new rejections in response to the Final Office Action in the Advisory Action, Applicant-Appellant's only opportunity to respond to the new rejections was in the Appeal Brief.

Applicant-Appellant requests reconsideration by the Patent Office and the Board of Appeals to remand this Appeal to the Examiner for the opportunity for Appellant to amend the claims and respond to the new grounds of rejection made in the final Office Action dated September 8, 2006. This is because the Examiner has not followed the MPEP and 37 CFR, and the Examiner has prevented Applicant-Appellant from either amending the claims or responding to the new grounds of rejection. Applicant-Appellant also submits that the Examiner has abused his discretion by, after refusing to let Applicant-Appellant amend the claims or respond to the new grounds of rejection, the Examiner then asserts that Applicant-Appellant has admitted that that newly cited art renders the pending claims to lack novelty and to be obvious!

Appellants provide the following details in support of each of the request for reconsideration grounds or remanding this application to the Examiner for further prosecution under the new grounds of rejection.

**(1) Making new grounds of rejection under 102(b) and 103(b) using newly cited art (GB 2,243,584) in the Final Office Action dated September 8, 2006.**

In the non-final Office Action dated March 14, 2006, the Examiner made prior art rejections of claims 1-20 under 102(a), (b) and 103(a) over JP 2002-114873 or JP 7-69003, in view of US5278141, 6220199, US2272981, JP 11-151908, FR 1498340, or further in view of KR 2004 029611. The Examiner did not make any rejections over any other references. In response, Appellants made clarifying amendments to claims 1, 4-10, 12-13 and 16-17 and canceled the remaining claims to further prosecution.

In the Final Office Action, the Examiner made a whole new set of rejections of all of the remaining claims under 102(b) and 103(a), newly citing GB 2,234,584, and further in view of KR 2004 029611, JP 2002-114873, DE 2949356, making one new rejection under 102(b) and one new rejection under 103(b).

The Examiner also repeated the rejections under 102(b) and 103(a) over JP 2002-114873, repeating the arguments made in the prior office action.

In response to the new grounds of rejection, Appellants filed a Response and Amendment dated December 8, 2006, requesting withdrawal of the finality of the Office Action and clarifying and distinguishing the claims over the cited references.

**(2) Failing to withdraw the finality of the Final Office Action as requested by Appellant on page 5 of the Amendment and Response filed December 8, 2006.**

In response to the new grounds of rejection, Appellants filed a Response and Amendment dated December 8, 2006, requesting withdrawal of the finality of the Office Action and clarifying and distinguishing the claims over the cited references:

**“REMARKS**

**Applicant requests that the final status of the present Office Action be removed, due to the fact that the Examiner has made new prior art rejections using different art and different combinations of art.”**

In the Advisory Action mailed January 4, 2007, the Examiner failed to withdraw the finality of the Final Office Action dated June 16, 2006, asserting that deletion of parts of claim 1 were deemed to be “extensive amendments” that “simultaneously broadened and narrowed claim 1, which was not part of the original dependent claims.” The Examiner also asserted that the amended claim 1 now newly read on natural scent.

However, the reasons made by the Examiner are not supported by the rejections and claim characterizations made by the Examiner. The Examiner continued to make 112 rejections of the use of the terms relating to fragrance added to the tires which resulted in Appellants amending the claims as suggested by the Examiner, and which did not read on natural scent of the tire, where the amended claims recited that a fragrance was incorporated into the insert, o-ring or plug and release upon use of the tire. This language excludes the Examiner’s characterization that the claims read on any natural scent of the tires. Accordingly the Examiner’s characterization of such “broadening” is incorrect.

Additionally the Examiner continued to make the same rejections of the claims using the same art as the prior non-final Office Action, such that the Examiner’s assertion that the claims amendments necessitated the new grounds of rejection is not supported by the record.

Accordingly, the Examiner should have properly removed the finality of the final office action dated September 8, 2006.

- (3) Failing to enter the Amendment and Response, dated December 8, 2006, including amendments to the claims and new arguments to address the new grounds of rejection**

When the Examiner did not remove the finality of the final office action and did site new art and made new rejections, then the Examiner should have entered the Response and Amendment to address the new ground of rejection, if only to provide an opportunity for Appellants to respond to the new grounds of rejection.

Accordingly, the Examiner should have properly entered the Response and Amendment field December 8, 2006.

**(4) On Appeal, failing to allow or enter arguments in response to address the new grounds of rejection.**

When the Examiner did enter the Response and Amendment filed December 8, 2006, to address the new ground of rejection, then Appellant must be given the opportunity to respond to the new grounds of rejection in the Appeal Brief as that is the only opportunity to do so.

Accordingly, the Examiner should have properly allowed the arguments entered the Appeal Brief February 5, 2007.

**(5) On Appeal, by Examiner's failing to allow or enter arguments in response to address the new grounds of rejection, the Examiner characterizes such failed entry as amounting to an admission by Appellant that the claims presented before the new grounds of rejection in the final office action lack novelty and obviousness under the new grounds of rejection.**

Applicant-Appellant also submits that the Examiner has abused his discretion by, after refusing to let Applicant-Appellant amend the claims or respond to the new grounds of rejection, the Examiner then asserts that Applicant-Appellant has admitted that that newly cited art renders the pending claims to lack novelty and to be obvious!

The Examiner has thus made new grounds of rejection, not allowed the Appellant to respond in either the Response to the final Office Action or the Appeal Brief, and then holds that after not allowing Appellant to address or respond to the new grounds of rejection, deeming such "non-response" to be an admission of lack of patentability of the claims of the new grounds of cited art that Appellant is not allowed to respond to.

**Conclusion**

In view of the above arguments and evidence of record, Appellants request that the case remanded to the Examiner for further consideration to let Appellants respond to the new grounds of rejection.

Respectfully submitted,



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**Date: November 13, 2007**



Application No. 10/822,049  
Art Unit: 1733  
Corrected Appeal Brief  
November 13, 2007

**BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Ronald J. Rosenberger**

(Name of Appellant, assignee, or Registered Representative)

*Ronald J. Rosenberger*

(Signature)

November 13, 2007

(Date of Signature)

**Commissioner for Patents**  
P. O. Box: 1450  
Alexandria, VA 22313-1450

**Attn: MAIL STOP APPEAL**

**APPELLANT'S CORRECTED BRIEF ON APPEAL UNDER 37 CFR 41.37**

Dear Sir:

In conjunction with the submitted and timely Notice of Appeal filed on December 8, 2006 and Brief on Appeal, filed February 8, 2007, Appellant submits the following Corrected Brief on Appeal under 37 CFR 41.37, now due November 16, 2007, in response to the Notice of Non-Compliant Appeal Brief, mailed October 16, 2007.

Appellant points out that, contrary to the statements made by the Examiner, that this Appeal Brief includes arguments for each ground of rejection, including new grounds of rejection made in the final Office Action dated September 8, 2006, which Response was not entered by the Examiner, and for which the Appeal Brief can provide such responses as required by MPEP1205.02.



The Examiner citing of MPEP 1205.02 is therefore misplaced for adding “new or non-admitted amendment, affidavit, or other evidence” which section of the MPEP does not include arguments or “language” and for which the Appellant is entitled to make such arguments, especially for addressing new grounds of rejection that Appellants had responded to, but which the Examiner did not enter and for which the Appeal Brief is the only place for Appellants to address.

Additionally Appellants point out that, also contrary to the Examiner, the prior and current Appeal Brief includes, inter alias, a statement of the status of the claims under 37 CFR.37(c)(1)(iii) (Page 3), a statement of the status of each amendment under 37 CFR.37(c)(1)(iv) (Page 3), a concise statement of each ground of rejection under 37 CFR.37(c)(1)(vi) (Page 4), an argument under separate heading for each ground of rejection on appeal under 37 CFR.37(c)(1)(vii) (Pages 5-12), and a correct copy of the appealed claims under 37 CFR.37(c)(1)(viii) (Appendix A).

Appellant also submits that the Examiner has abused his discretion by, after refusing to let Applicant-Appellant amend the claims or respond to the new grounds of rejection, the Examiner then asserts that Applicant-Appellant has admitted that that newly cited art renders the pending claims to lack novelty and to be obvious!

#### **Real Party in Interest (37 CFR 41.37(c)(1)(i))**

The Appellant-inventor, Ronald Rosenberger is the owner of entire interest in the above-identified patent application as the sole Appellant, and which interest has not been assigned.

#### **Related Appeals and Interferences (37 CFR 41.37(c)(1)(ii))**

There are no related appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal and accordingly there are no decisions to provide copies herewith.

**Status of Claims (37 CFR 41.37(c)(1)(iii))**

Pending original and previously amended claims 1-2, 4-10, 12-13 and 16-17 including independent claim 1, all stand rejected and are on appeal. Claims 3, 11, 14-15 were previously canceled.

**Status of Amendments (37 CFR 41.37(c)(1)(iv))**

The Examiner did not enter an Amendment under 37 CFR 1.16, mailed on December 08, 2006, in response to the final Office Action mailed September 8, 2006, as indicated in an Advisory Action of record. The Examiner maintained his rejections as indicated in the Advisory Action. Accordingly, the claims stand for the present Appeal in the form they were amended and canceled in the Amendment and Response filed June 14, 2006 to the Office Action of March 14, 2006.

**Summary of Claimed Subject Matter (37 CFR 41.37(c)(1)(v))**

Pending claims 1-2, 4-10, 12-13 and 16-17 cover particular aspect of the present invention, which provides, e.g., in claim 1, a vehicle tire comprising voids comprising removable inserts, o-rings or plugs that comprise at least one scent or fragrance that is released by friction, heat or wear when the vehicle with the vehicle tire is driven. The following table provides each independent claim and its corresponding support in the specification.

<b><u>Independent claim</u></b>	<b><u>Specification Support</u></b>
1. A vehicle tire, comprising at least one removable insert, o-ring or plug provided in at least one void contained adjacent to the outside surface of at least one of a tread, a belt or a ply of said vehicle tire, said insert,	Claim 1 as filed: A vehicle tire comprising at least one novelty scented rubber compound, and/or at least one novelty scented non-rubber component, where said novelty scented rubber compound and/or said novelty scented component comprises at least one novelty scent or fragrance, where said novelty scented rubber compound and/or said novelty scented non-rubber component gives off a unique aroma when said tire is at rest, where said novelty scented rubber compound and/or said novelty scented non-rubber component gives off a unique aroma when said tire is in normal use due to friction, heat buildup, and wear; and where normal wear of said vehicle tire exposes fresh surface area of said novelty scented rubber compound, and/or said novelty scented non-rubber component, wherein said unique aroma comprises a salient,

<p>o-ring or plug comprising at least one that is released when said tire is <del>in normal</del> used in a vehicle for driving, said release of said scent or fragrance due to friction, heat buildup, or wear.</p>	<p>distinctive, and marketable feature of said vehicle tire.</p> <p>(Page 13, 2<sup>nd</sup> full paragraph) The novelty plug or insert is intended to be installable on the outside surface of a tire. While theoretically the novelty plug or insert should be installable anywhere on the outside surface of the tire, it is apparent that the most optimal situation would place the novelty plug or insert comprising erodible material in the tread of the tire, with the novelty plug or insert exposed and visible on the tire's tread. Such an embodiment would permit friction and heat build-up, as well as wear, that would stimulate the release of the novelty scent or fragrance. For this reason, it is preferred that the outside surface of the novelty plug or insert be flush with the outside tire surface, and not be recessed in any way. The novelty plug or insert can be installed on the disclosed vehicle tire that comprises novelty scented rubber compound and/or novelty scented non-rubber component, and/or pheromones, and/or wear warning oriented rubber compound and/or wear warning oriented non-rubber components, or it may be installed on tires that do not comprise any one or all of the abovementioned attributes</p> <p>(Page 14, first full paragraph) The novelty plug or insert can comprise any shape, design, size or depth. For example, the novelty plug or insert may appear in the tire as being circular in shape, a quarter inch wide and a quarter inch deep; or, shaped like the State of Texas, an inch across; or, can comprise a lined design, such as a Celtic symbol an inch and a half high. Also, the novelty plug or insert can comprise any embodiment of an "O" ring around the tread circumference or tire wall diameter of the vehicle tire. Also, a given "O" ring could even be elastic or semi-elastic, and perhaps have qualities similar to a rubber band or an elastic hair band that can be stretched on or off the tire, and can be easily replaced at will.</p>
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**Grounds of Rejection to be reviewed on Appeal (37 CFR 41.37(c)(1)(vi))**

1. The Examiner objects to claims 6-9 and 16 under 35 USC 112, second paragraph, asserting that the use of the term “groove, channel or device: is confusing, and suggests change to “void comprises”.
2. The Examiner objects to claim 10 under 37 CFR 175(c), asserting that the claim’s adding “removable” as a dependent feature broadens the claim.
3. The Examiner rejects claims 1, 4-10, 12-13 and 16-17 under 35 USC section 102 (b) as being anticipated by Great Britain 584 (GB 2,243,584).
4. The Examiner rejects claims 3 and 4 under 35 USC 103(a) as unpatentable over Britain 584 in view of Korea (2004029611), Japan 873 or German 356
5. The Examiner rejects claims 3-11 and 13-20 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908.
6. The Examiner rejects claim 2 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, and further in view of Berliner
7. The Examiner rejects claims 4 and 13 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, and further in view of Berliner
8. The Examiner rejects claim 12 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, and further in view of Mellet et al (WO 01/43958).

**Arguments (37 CFR 41.37(c)(1)(vii))**

All of the claims, including independent claim 1 and dependent claims 4-10, 12-13 and 16-17 are argued together.

**Argument 1 under (37 CFR 41.37(c)(1)(vii))**

The Examiner objects to claims 6-9 and 16 under 35 USC 112, second paragraph, asserting that the use of the term “groove, channel or device: is confusing, and suggests change to “void comprises”.

The Examiner objects to claims 6-9 and 16 under 35 USC 112, second paragraph, asserting that the use of the term “groove, channel or device: is confusing, and suggests change to “void comprises”. In response to the final Office Action to reduce issues on Appeal, but which response was not entered by the Examiner, Appellant deleted this term, and clarified that the insert, o-ring or plug comprises a particular shape, design, directional orientation, size, or depth, rendering this objection moot. Appellant would be willing to so amend the claims to remove this rejection. This obviousness rejection should be reversed as being in error.

**Argument 2 under (37 CFR 41.37(c)(1)(vii))**

The Examiner objects to claim 10 under 37 CFR 175(c), asserting that the claim’s adding “removable” as a dependent feature broadens the claim.

The Examiner objects to claim 10 under 37 CFR 175(c), asserting that the claim’s adding “removable” as a dependent feature broadens the claim. In response to the final Office Action to reduce issues on Appeal, but which response was not entered by the Examiner, Appellant deleted this term, rendering this rejection moot. Appellant would be willing to so amend the claims to remove this rejection. This obviousness rejection should be reversed as being in error.

**Argument 3 under (37 CFR 41.37(c)(1)(vii))**

The Examiner rejects claims 1, 4-10, 12-13 and 16-17 under 35 USC section 102 (b) as being anticipated by Great Britain 584 (GB 2,243,584).

The Examiner rejects claims 1, 4-10, 12-13 and 16-17 under 35 USC section 102 (b) as being anticipated by Great Britain 584 (GB 2,243,584). The Examiner asserts that this reference discloses a vehicle tire having grooves and removable wear indicators inserted therein, and that the wear indicator gives off an inherent scent. The Examiner asserts that Britain 584 discloses the other features of the dependent claims.

The Examiner notes that terms such as novelty, unique aroma and salient, distinctive and marketable features of the scent were deleted from claim 1. Appellant points out

that the Examiner, in the Office Action of March 14, 2006, rejected all of these terms as indefinite. Since the Examiner has now used the removal of these terms, in hindsight, to attempt to read the claims on the prior art, Appellant amended the claims to clarify that the scent or fragrance is incorporated as a scent or fragrance in a plug or insert to the vehicle tire, which claims the same invention as using the above terms which the Examiner has failed to consider patentable in claims under 35 USC 102, second paragraph. The amendments to the claims are fully supported by the priority specification, dated 4-17-03, e.g., as presented above as well as in the sentence preceding and including the first paragraph of the Description of the Invention section as follows:

Finally, a less invasive means for scenting a vehicle tire comprising a novelty plug or insert is disclosed.

#### DESCRIPTION OF THE INVENTION

The disclosed scented vehicle tire may be realized in myriad ways and combinations. Scent may be made apparent in the vehicle tire by incorporating novelty scent or fragrance in or on the rubber compound(s) comprising a given vehicle tire, in or on the any of the non-rubber components of a given tire, or on any combination of a given tire's rubber compound(s) and non-rubber components.

(Emphasis added.)

Appellant respectfully points out that the cited art fails to disclose, teach or suggest the use of an added scent or fragrance compound in a plug or insert that gives off the scent or fragrance when the vehicle tire is used but does not include the use of the scent as a tire wear indicator. The Examiner has improperly used hindsight to improperly assert that the claims are obvious over the cited references, which fail to provide any teaching or suggestion or motivation to combine or interpret the cited references to provide the claimed invention:

Appellant respectfully points out that the references in themselves do not suggest or motivate the presently claimed combination, and the Examiner has failed to show how the general knowledge suggests the combination, as required by MPEP 706.02(k) and MPEP 2143.01, which also states that "the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion

to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP sections 2143–2143.03." The Examiner has failed to show how the references or the state of the art specifically suggest the presently claimed combination.

MPEP 2143.01 cites "*In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-8 (Fed. Cir. 1998) (the combination of the references taught every element of the claimed invention, however, without a motivation to combine, a rejection based on a *prima facie* case of obviousness was improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) . . .The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) . . .A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000)

This obviousness rejection should be reversed as being in error.

**Argument 4 under (37 CFR 41.37(c)(1)(vii))**

The Examiner rejects claims 3 and 4 under 35 USC 103(a) as unpatentable over Britain 584 in view of Korea (2004029611), Japan 873 or German 356.

The Examiner rejects claims 3 and 4 under 35 USC 103(a) as unpatentable over Britain 584 in view of Korea (2004029611), Japan 873 or German 356. The presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or

friction when the tire is driven on, which invention is not suggested or taught by the cited references, alone or in combination. Additionally there is no motivation to combine the teachings of the cited references to provide the presently claimed combination. Britain 584 fails to suggest an incorporated scent or fragrance given off due to friction, use or heat and Korea's use of encapsulated fragrance as a wear indicator to be activated at the time the tire needs to be replaced does not make up the deficiencies of Britain 584. Japan 873 teaches perfume-sealed particles that are incorporated into the rubber composition of the tire and not into a plug, insert or o-ring as presently claimed. German 356 discloses a wear indicator that is activated when the tire needs to be replaced as in Japan 873 which may emit a noise, smoke or smell. German 356 fails to suggest that the "smell" can be emitted whenever the tire is exposed to normal use, as presently claimed.

Accordingly, the cited references fail to disclose, teach or suggest each and every element of the present claims. The present claims distinguish over the cited reference(s). This obviousness rejection should be reversed as being in error.

**Argument 5 under (37 CFR 41.37(c)(1)(vii))**

The Examiner rejects claims 3-11 and 13-20 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, for the reasons presented in the Office Action.

The presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or friction when the tire is driven on, which invention is not suggested or taught by the cited references, alone or in combination. Additionally there is no motivation to combine the teachings of the cited references to provide the presently claimed combination. Japan 873 teaches perfume-sealed particles that might be incorporated into the rubber composition of the tire. Japan 873 fails to teach or suggest a scent or fragrance added to a tire plug or inserts presently claimed. French 013 teaches bike tire with inner and outer non-slip tread patterns with trough that can be colored. Canada 958 discloses tire with replaceable insert to replace worn tread. Japan 908



discloses o-rings to add in the grooves between the treads to add non-black color to decorate the tire.

The presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or friction when the tire is driven on, which invention is not suggested or taught by the cited references, alone or in combination. Additionally there is no motivation to combine the teachings of the cited references to provide the presently claimed combination.

Accordingly, the cited references fail to disclose, teach or suggest each and every element of the present claims. The present claims distinguish over the cited reference(s). This obviousness rejection should be reversed as being in error.

**Argument 6 under (37 CFR 41.37(c)(1)(vii))**

The Examiner rejects claim 2 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, and further in view of Berliner, for the reasons presented in the Office Action.

The presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or friction when the tire is driven on, which invention is not suggested or taught by the cited references, alone or in combination. Additionally there is no motivation to combine the teachings of the cited references to provide the presently claimed combination. Japan 873 teaches perfume-sealed particles that might be incorporated into the rubber composition of the tire. Japan 873 fails to teach or suggest a scent or fragrance added to a tire plug or insert as presently claimed. French 013 teaches bike tire with inner and outer non-slip tread patterns with trough that can be colored. Canada 958 discloses tire with replaceable insert to replace worn tread. Japan 908 discloses o-rings to add in the grooves between the treads to add non-black color to decorate the tire. Berliner's suggestion of adding pheromone to perfume does not make up for the deficiencies of the other references and there is no suggestion in Berliner to combine its teaches for use in a scented tire.

Accordingly, the cited references fail to disclose, teach or suggest each and every element of the present claims. The present claims distinguish over the cited reference(s). This obviousness rejection should be reversed as being in error.

**Argument 7 under (37 CFR 41.37(c)(1)(vii))**

The Examiner rejects claims 4 and 13 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, and further in view of Berliner, for the reasons presented in the Office Action.

The presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or friction when the tire is driven on, which invention is not suggested or taught by the cited references, alone or in combination. Additionally there is no motivation to combine the teachings of the cited references to provide the presently claimed combination. Japan 873 teaches perfume-sealed particles that might be incorporated into the rubber composition of the tire. Japan 873 fails to teach or suggest a scent or fragrance added to a tire plug or insert as presently claimed. French 013 teaches bike tire with inner and outer non-slip tread patterns with trough that can be colored. Canada 958 discloses tire with replaceable insert to replace worn tread. Japan 908 discloses o-rings to add in the grooves between the treads to add non-black color to decorate the tire. French 340 suggesting (according to the Examiner) colored o-rings or grooves for a particular color scheme or colored rubber or tearable cell wear indicator (not presently claimed) fails to make up for the deficiencies of the primary references.

Accordingly, the cited references fail to disclose, teach or suggest each and every element of the present claims. The present claims distinguish over the cited reference(s). This obviousness rejection should be reversed as being in error.

**Argument 8 under (37 CFR 41.37(c)(1)(vii))**

The Examiner rejects claim 12 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, and further in view of Mellet et al (WO 01/43958), for the reasons presented in the Office Action.

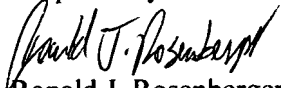
The presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or friction when the tire is driven on, which invention is not suggested or taught by the cited references, alone or in combination. Additionally there is no motivation to combine the teachings of the cited references to provide the presently claimed combination. Japan 873 teaches perfume-sealed particles that might be incorporated into the rubber composition of the tire. Japan 873 fails to teach or suggest a scent or fragrance added to a tire plug or insert as presently claimed. French 013 teaches bike tire with inner and outer non-slip tread patterns with trough that can be colored. Canada 958 discloses tire with replaceable insert to replace worn tread. Japan 908 discloses o-rings to add in the grooves between the treads to add non-black color to decorate the tire. Mellet et al teaches colored covers that fit into grooves between tread of a bike tire. Mellet fails to make up for the deficiencies of the other references.

Accordingly, the cited references fail to disclose, teach or suggest each and every element of the present claims. The present claims distinguish over the cited reference(s). This obviousness rejection should be reversed as being in error.

**Conclusion**

In view of the above arguments and evidence of record, Appellants request that the Examiner's rejections be reversed and the case remanded to the Examiner for allowance.

Respectfully submitted,

  
Ronald J. Rosenberger, Appellant  
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(215) 579-9871

**Date: November INSERT, 2007**

**CLAIMS ON APPEAL**

1. (Previously Amended) A vehicle tire, comprising at least one removable insert, o-ring or plug provided in at least one void contained adjacent to the outside surface of at least one of a tread, a belt or a ply of said vehicle tire, said insert, o-ring or plug comprising at least one scent or fragrance that is released when said tire is used in a vehicle for driving, said release of said scent or fragrance due to friction, heat buildup, or wear.
2. (Previously Amended) The vehicle tire of claim 1, wherein said at least one insert, o-ring or plug further comprises.
4. (Previously Amended) The vehicle tire of claim 1, wherein said vehicle tire further comprises at least one wear warning component comprising at least one of a wear warning scent, visible wear warning non-colored or colored smoke, or visible wear warning powder that optionally leaves a residue, wherein the intensity or timing of the release of said wear warning component is proportional to the wear level of said vehicle tire.
  5. (Previously Amended) The vehicle tire of claim 1, wherein said insert, o-ring or plug is color coordinated with said scent or fragrance, or wherein the color of said insert, o-ring or plug is incongruous with said scent or fragrance.
  6. (Previously Amended) The vehicle tire of claim 1, wherein said void, insert, o-ring or plug comprises a particular shape, design, directional orientation, size, or depth, or a groove, channel, or crevice.
  7. (Previously Amended) The vehicle tire of claim 6, wherein said vehicle tire further comprises at least one void anywhere on the outside surface of said tire, said void providing for placement or replacement of at least one additional insert, o-ring or plug comprising at least one of a fragrance, a scent, a pheromone or a wear warning component.
  8. (Previously Amended) The vehicle tire of claim 6, wherein said vehicle tire is selected from a vehicle tire for at least one of an automobile, a sport utility vehicle, a minivan; a heavy machinery work vehicle, a truck, a farm equipment vehicle, an aircraft; a bus; a motorcycle, a scooters, a motorbike; an all-terrain vehicle, a golf cart, a go cart; a bicycle, a unicycle, a tricycles, or an exercise bike.

9. (Previously Amended) The vehicle tire of claim 6, wherein at least one of said at least one void can accommodate two or more of at least one of said plug, o-ring or insert.
10. (Previously Amended) The vehicle tire of claim 1, wherein said plug, o-ring or insert:
- comprises at least one color
  - is inserted, installed or secured in said void
  - is removable from said at least one void of said vehicle tire; or
  - comprises an embodiment of an "O" ring around the circumference or diameter of said vehicle tire.
12. (Previously Amended) The vehicle tire of claim 1, wherein said insert, o-ring or plug further comprises at least one visual aspect selected from a reflective component, a refractive component, a sparkling component, a shining component, a holographic component, a jewel-like component, a luminescent component, a pearlescent component, a fluorescent component, or a glow-in-the dark component.
13. (Previously Amended) The vehicle tire of claim 4, wherein said wear warning component comprises at least one wear warning plug, o-ring or insert is oriented in said vehicle tire such that deployment occurs at a predetermined level of wear of said vehicle tire, and wherein said wear warning plug, o-ring or insert comprises: 1) at least one wear warning composition comprising at least one wear warning scent, visible wear warning colored or non-colored smoke, or wear warning powder; or, 2) at least one capsules or microcapsule comprising said at least one wear warning composition, said capsule or microcapsule rupturing with exposure due to wear, thereby releasing said wear warning composition, wherein the level of said release of said wear warning composition is proportional to the wear level of said vehicle tire.
16. (Previously Amended) The vehicle tire of claim 7, comprising wherein said plug, o-ring or insert, provided for placement in said void, comprises semi-solids that are introduced into said void using at least one method selected from pouring, pumping, injecting, or spraying.
17. (Previously Amended) The vehicle tire of claim 1, wherein said plug, o-ring or insert comprises two or more sections, wherein at least one said at least one

color; at least one scent or fragrance; at least one pheromone; at least one visual aspect; or at least one wear warning component.

**Evidence Appendix Under 41.37(c)(1)(ix)**

NONE.

There is no related evidence under 37 C.F.R. 1.130, 1.131, or 1.132 being filed with this Brief on Appeal.

**Related Proceedings Appendix Under 41.37(c)(1)(x)**

NONE.

There are no related proceedings pursuant to 41.37(c)(1)(ii).





Application No. 10/822,049

Art Unit: 1733

Request for reconsideration to Remand Appeal Brief

November 13, 2007

**BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: RONALD JOHN ROSENBERGER

Application No.: 10/822,049 Art. Unit: 1733

Filing Date: 04/10/2004 Examiner: Steven D. Maki

Title: **SCENTED TIRES**

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to: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

November 13, 2007

(Date of Deposit)

**Ronald J. Rosenberger**

(Name of applicant, assignee, or Registered Representative)

*Ronald J. Rosenberger*

(Signature)

November 13, 2007

(Date of Signature)

**Commissioner for Patents**

P. O. Box: 1450

Alexandria, VA 22313-1450

**Attn: MAIL STOP APPEAL**

**REQUEST FOR RECONSIDERATION TO REMAND APPLICATION IN  
VIEW OF EXAMINER'S:**

- (1) MAKING NEW GROUNDS OF REJECTION UNDER FINAL OFFICE ACTION;**
- (2) FAILURE TO REMOVE NON-FINAL STATUS OF OFFICE ACTION WITH NEW GROUNDS OF REJECTION;**
- (3) FAILURE TO ENTER AMENDMENT IN RESPONSE TO NEW GROUNDS OF REJECTION**
- (4) FAILURE TO ALLOW ENTRY OF RESPONSE TO NEW GROUNDS OF REJECTION ON APPEAL; AND**
- (5) ASSERTING THAT FAILURE TO ALLOW ENTRY OF RESPONSE TO NEW GROUNDS OF REJECTION ON APPEAL CONSTITUTE APPELLANT'S ADMISSION OF UNPATENTABILITY OF APPEALED CLAIMS**

Dear Sir:

Applicant-Appellant files this Request for Reconsideration, based on the following remarks, in conjunction with the response to the Notice of Non-Compliant Appeal Brief, mailed October 16, 2007, which is submitted herewith, in conjunction with the submitted and timely Notice of Appeal filed on December 8, 2006 and Brief on Appeal, filed February 8, 2007, Applicant-Appellant submits the following Corrected Brief on Appeal under 37 CFR 41.37, now due November 16, 2007, in response to the Notice of Non-Compliant Appeal Brief, mailed October 16, 2007.

### **REMARKS**

Appellant-Applicant requests reconsideration by the Board of Appeals to have the pending appeal remanded to the Examiner for one or all of the following bases:

- (1) making new grounds of rejection under 102(b) and 103(b) using newly cited art (GB2,243,584) in the Final Office Action dated September 8, 2006,
- (2) failing to withdraw the finality of the Final Office Action as requested by Appellant on page 5 of the Amendment and Response filed December 8, 2006, and
- (3) failing to enter the Amendment and Response, dated December 8, 2006, including amendments to the claims and new arguments to address the new grounds of rejection; and
- (4) on Appeal, failing to allow or enter arguments in response to address the new grounds of rejection;
- (5) on Appeal, by Examiner's failing to allow or enter arguments in response to address the new grounds of rejection, the Examiner characterizes such failed entry as amounting to an admission by Appellant that the claims presented before the new grounds of rejection in the final office action lack novelty and obviousness under the new grounds of rejection.

In the Notice of Non-Compliant Amendment Appeal Brief, dated October 16, 2007, in the pending Appeal, the Examiner has requested "corrections" to the Appeal Brief by Applicant-Appellant arguing that since some arguments were presented that were made

to a new ground of rejection in the after final Response filed December 8, 2006, but not entered by the Examiner, and such arguments made in Appeal Brief are not Admissible.

However, the Examiner fails to point out or acknowledge that, since the Examiner made new made grounds of rejection in the Final Office Action dated September 8, 2006 over newly cited reference GB 2,243,584 under 102(b) and 103(a) of pending claims 1, 4-10, 12-13 and 16-17, which constituted a new ground of rejection first presented by the Examiner in the Final Office Action, Applicant did not have any other opportunity to present any claim amendments or arguments to those new rejections until the Appeal Brief. This is because the Examiner failed to allow entry of the Response filed December 8, 2006.

Accordingly, if the Examiner made new rejections in the Final Office Action, did not remove the finality of the Final Office Action, and then did not enter Appellant-Applicant's claim amendments and response to those new rejections in response to the Final Office Action in the Advisory Action, Applicant-Appellant's only opportunity to respond to the new rejections was in the Appeal Brief.

Applicant-Appellant requests reconsideration by the Patent Office and the Board of Appeals to remand this Appeal to the Examiner for the opportunity for Appellant to amend the claims and respond to the new grounds of rejection made in the final Office Action dated September 8, 2006. This is because the Examiner has not followed the MPEP and 37 CFR, and the Examiner has prevented Applicant-Appellant from either amending the claims or responding to the new grounds of rejection. Applicant-Appellant also submits that the Examiner has abused his discretion by, after refusing to let Applicant-Appellant amend the claims or respond to the new grounds of rejection, the Examiner then asserts that Applicant-Appellant has admitted that that newly cited art renders the pending claims to lack novelty and to be obvious!

Appellants provide the following details in support of each of the request for reconsideration grounds or remanding this application to the Examiner for further prosecution under the new grounds of rejection.

**(1) Making new grounds of rejection under 102(b) and 103(b) using newly cited art (GB 2,243,584) in the Final Office Action dated September 8, 2006.**

In the non-final Office Action dated March 14, 2006, the Examiner made prior art rejections of claims 1-20 under 102(a), (b) and 103(a) over JP 2002-114873 or JP 7-69003, in view of US5278141, 6220199, US2272981, JP 11-151908, FR 1498340, or further in view of KR 2004 029611. The Examiner did not make any rejections over any other references. In response, Appellants made clarifying amendments to claims 1, 4-10, 12-13 and 16-17 and canceled the remaining claims to further prosecution.

In the Final Office Action, the Examiner made a whole new set of rejections of all of the remaining claims under 102(b) and 103(a), newly citing GB 2,234,584, and further in view of KR 2004 029611, JP 2002-114873, DE 2949356, making one new rejection under 102(b) and one new rejection under 103(b).

The Examiner also repeated the rejections under 102(b) and 103(a) over JP 2002-114873, repeating the arguments made in the prior office action.

In response to the new grounds of rejection, Appellants filed a Response and Amendment dated December 8, 2006, requesting withdrawal of the finality of the Office Action and clarifying and distinguishing the claims over the cited references.

**(2) Failing to withdraw the finality of the Final Office Action as requested by Appellant on page 5 of the Amendment and Response filed December 8, 2006.**

In response to the new grounds of rejection, Appellants filed a Response and Amendment dated December 8, 2006, requesting withdrawal of the finality of the Office Action and clarifying and distinguishing the claims over the cited references:

**“REMARKS**

Applicant requests that the final status of the present Office Action be removed, due to the fact that the Examiner has made new prior art rejections using different art and different combinations of art.”

In the Advisory Action mailed January 4, 2007, the Examiner failed to withdraw the finality of the Final Office Action dated June 16, 2006, asserting that deletion of parts of claim 1 were deemed to be “extensive amendments” that “simultaneously broadened and narrowed claim 1, which was not part of the original dependent claims.” The Examiner also asserted that the amended claim 1 now newly read on natural scent.

However, the reasons made by the Examiner are not supported by the rejections and claim characterizations made by the Examiner. The Examiner continued to make 112 rejections of the use of the terms relating to fragrance added to the tires which resulted in Appellants amending the claims as suggested by the Examiner, and which did not read on natural scent of the tire, where the amended claims recited that a fragrance was incorporated into the insert, o-ring or plug and release upon use of the tire. This language excludes the Examiner’s characterization that the claims read on any natural scent of the tires. Accordingly the Examiner’s characterization of such “broadening” is incorrect.

Additionally the Examiner continued to make the same rejections of the claims using the same art as the prior non-final Office Action, such that the Examiner’s assertion that the claims amendments necessitated the new grounds of rejection is not supported by the record.

Accordingly, the Examiner should have properly removed the finality of the final office action dated September 8, 2006.

- (3) Failing to enter the Amendment and Response, dated December 8, 2006, including amendments to the claims and new arguments to address the new grounds of rejection**

When the Examiner did not remove the finality of the final office action and did site new art and made new rejections, then the Examiner should have entered the Response and Amendment to address the new ground of rejection, if only to provide an opportunity for Appellants to respond to the new grounds of rejection.

Accordingly, the Examiner should have properly entered the Response and Amendment field December 8, 2006.

**(4) On Appeal, failing to allow or enter arguments in response to address the new grounds of rejection.**

When the Examiner did enter the Response and Amendment filed December 8, 2006, to address the new ground of rejection, then Appellant must be given the opportunity to respond to the new grounds of rejection in the Appeal Brief as that is the only opportunity to do so.

Accordingly, the Examiner should have properly allowed the arguments entered the Appeal Brief February 5, 2007.

**(5) On Appeal, by Examiner's failing to allow or enter arguments in response to address the new grounds of rejection, the Examiner characterizes such failed entry as amounting to an admission by Appellant that the claims presented before the new grounds of rejection in the final office action lack novelty and obviousness under the new grounds of rejection.**

Applicant-Appellant also submits that the Examiner has abused his discretion by, after refusing to let Applicant-Appellant amend the claims or respond to the new grounds of rejection, the Examiner then asserts that Applicant-Appellant has admitted that that newly cited art renders the pending claims to lack novelty and to be obvious!

The Examiner has thus made new grounds of rejection, not allowed the Appellant to respond in either the Response to the final Office Action or the Appeal Brief, and then holds that after not allowing Appellant to address or respond to the new grounds of rejection, deeming such "non-response" to be an admission of lack of patentability of the claims of the new grounds of cited art that Appellant is not allowed to respond to.

**Conclusion**

In view of the above arguments and evidence of record, Appellants request that the case remanded to the Examiner for further consideration to let Appellants respond to the new grounds of rejection.

Respectfully submitted,



Ronald J. Rosenberger

Applicant

ronrosenberger@hotmail.com

(215) 579-9871

**Date: November 13, 2007**



**BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellant: RONALD JOHN ROSENBERGER  
Application No.: 10/822,049 Art. Unit: 1733  
Filing Date: 04/10/2004 Examiner: Steven D. Maki

Title: **SCENTED TIRES**

I hereby certify that this correspondence is being deposited with the  
United States Postal Service as first class mail in an envelope addressed  
to: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

November 13, 2007

(Date of Deposit)

**Ronald J. Rosenberger**

(Name of Appellant, assignee, or Registered Representative)

*Ronald J. Rosenberger*

(Signature)

November 13, 2007

(Date of Signature)

**Commissioner for Patents**  
P. O. Box: 1450  
Alexandria, VA 22313-1450

**Attn: MAIL STOP APPEAL**

**APPELLANT'S CORRECTED BRIEF ON APPEAL UNDER 37 CFR 41.37**

Dear Sir:

In conjunction with the submitted and timely Notice of Appeal filed on December 8, 2006 and Brief on Appeal, filed February 8, 2007, Appellant submits the following Corrected Brief on Appeal under 37 CFR 41.37, now due November 16, 2007, in response to the Notice of Non-Compliant Appeal Brief, mailed October 16, 2007.

Appellant points out that, contrary to the statements made by the Examiner, that this Appeal Brief includes arguments for each ground of rejection, including new grounds of rejection made in the final Office Action dated September 8, 2006, which Response was not entered by the Examiner, and for which the Appeal Brief can provide such responses as required by MPEP1205.02.



The Examiner citing of MPEP 1205.02 is therefore misplaced for adding “new or non-admitted amendment, affidavit, or other evidence” which section of the MPEP does not include arguments or “language” and for which the Appellant is entitled to make such arguments, especially for addressing new grounds of rejection that Appellants had responded to, but which the Examiner did not enter and for which the Appeal Brief is the only place for Appellants to address.

Additionally Appellants point out that, also contrary to the Examiner, the prior and current Appeal Brief includes, inter alias, a statement of the status of the claims under 37 CFR.37(c)(1)(iii) (Page 3), a statement of the status of each amendment under 37 CFR.37(c)(1)(iv) (Page 3), a concise statement of each ground of rejection under 37 CFR.37(c)(1)(vi) (Page 4), an argument under separate heading for each ground of rejection on appeal under 37 CFR.37(c)(1)(vii) (Pages 5-12), and a correct copy of the appealed claims under 37 CFR.37(c)(1)(viii) (Appendix A).

Appellant also submits that the Examiner has abused his discretion by, after refusing to let Applicant-Appellant amend the claims or respond to the new grounds of rejection, the Examiner then asserts that Applicant-Appellant has admitted that that newly cited art renders the pending claims to lack novelty and to be obvious!

**Real Party in Interest (37 CFR 41.37(c)(1)(i))**

The Appellant-inventor, Ronald Rosenberger is the owner of entire interest in the above-identified patent application as the sole Appellant, and which interest has not been assigned.

**Related Appeals and Interferences (37 CFR 41.37(c)(1)(ii))**

There are no related appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal and accordingly there are no decisions to provide copies herewith.

**Status of Claims (37 CFR 41.37(c)(1)(iii))**

Pending original and previously amended claims 1-2, 4-10, 12-13 and 16-17 including independent claim 1, all stand rejected and are on appeal. Claims 3, 11, 14-15 were previously canceled.

**Status of Amendments (37 CFR 41.37(c)(1)(iv))**

The Examiner did not enter an Amendment under 37 CFR 116, mailed on December 08, 2006, in response to the final Office Action mailed September 8, 2006, as indicated in an Advisory Action of record. The Examiner maintained his rejections as indicated in the Advisory Action. Accordingly, the claims stand for the present Appeal in the form they were amended and canceled in the Amendment and Response filed June 14, 2006 to the Office Action of March 14, 2006.

**Summary of Claimed Subject Matter (37 CFR 41.37(c)(1)(v))**

Pending claims 1-2, 4-10, 12-13 and 16-17 cover particular aspect of the present invention, which provides, e.g., in claim 1, a vehicle tire comprising voids comprising removable inserts, o-rings or plugs that comprise at least one scent or fragrance that is released by friction, heat or wear when the vehicle with the vehicle tire is driven. The following table provides each independent claim and its corresponding support in the specification.

<b><u>Independent claim</u></b>	<b><u>Specification Support</u></b>
1. A vehicle tire, comprising at least one removable insert, o-ring or plug provided in at least one void contained adjacent to the outside surface of at least one of a tread, a belt or a ply of said vehicle tire, said insert,	Claim 1 as filed: A vehicle tire comprising at least one novelty scented rubber compound, and/or at least one novelty scented non-rubber component, where said novelty scented rubber compound and/or said novelty scented component comprises at least one novelty scent or fragrance, where said novelty scented rubber compound and/or said novelty scented non-rubber component gives off a unique aroma when said tire is at rest, where said novelty scented rubber compound and/or said novelty scented non-rubber component gives off a unique aroma when said tire is in normal use due to friction, heat buildup, and wear; and where normal wear of said vehicle tire exposes fresh surface area of said novelty scented rubber compound, and/or said novelty scented non-rubber component, wherein said unique aroma comprises a salient,

<p>o-ring or plug comprising at least one that is released when said tire is <del>in normal</del> used in a vehicle for driving, said release of said scent or fragrance due to friction, heat buildup, or wear.</p>	<p>distinctive, and marketable feature of said vehicle tire.</p> <p>(Page 13, 2<sup>nd</sup> full paragraph) The novelty plug or insert is intended to be installable on the outside surface of a tire. While theoretically the novelty plug or insert should be installable anywhere on the outside surface of the tire, it is apparent that the most optimal situation would place the novelty plug or insert comprising erodible material in the tread of the tire, with the novelty plug or insert exposed and visible on the tire's tread. Such an embodiment would permit friction and heat build-up, as well as wear, that would stimulate the release of the novelty scent or fragrance. For this reason, it is preferred that the outside surface of the novelty plug or insert be flush with the outside tire surface, and not be recessed in any way. The novelty plug or insert can be installed on the disclosed vehicle tire that comprises novelty scented rubber compound and/or novelty scented non-rubber component, and/or pheromones, and/or wear warning oriented rubber compound and/or wear warning oriented non-rubber components, or it may be installed on tires that do not comprise any one or all of the abovementioned attributes</p> <p>(Page 14, first full paragraph) The novelty plug or insert can comprise any shape, design, size or depth. For example, the novelty plug or insert may appear in the tire as being circular in shape, a quarter inch wide and a quarter inch deep; or, shaped like the State of Texas, an inch across; or, can comprise a lined design, such as a Celtic symbol an inch and a half high. Also, the novelty plug or insert can comprise any embodiment of an "O" ring around the tread circumference or tire wall diameter of the vehicle tire. Also, a given "O" ring could even be elastic or semi-elastic, and perhaps have qualities similar to a rubber band or an elastic hair band that can be stretched on or off the tire, and can be easily replaced at will.</p>
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**Grounds of Rejection to be reviewed on Appeal (37 CFR 41.37(c)(1)(vi))**

1. The Examiner objects to claims 6-9 and 16 under 35 USC 112, second paragraph, asserting that the use of the term “groove, channel or device: is confusing, and suggests change to “void comprises”.
2. The Examiner objects to claim 10 under 37 CFR 175(c), asserting that the claim’s adding “removable” as a dependent feature broadens the claim.
3. The Examiner rejects claims 1, 4-10, 12-13 and 16-17 under 35 USC section 102 (b) as being anticipated by Great Britain 584 (GB 2,243,584).
4. The Examiner rejects claims 3 and 4 under 35 USC 103(a) as unpatentable over Britain 584 in view of Korea (2004029611), Japan 873 or German 356
5. The Examiner rejects claims 3-11 and 13-20 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908.
6. The Examiner rejects claim 2 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, and further in view of Berliner
7. The Examiner rejects claims 4 and 13 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, and further in view of Berliner
8. The Examiner rejects claim 12 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, and further in view of Mellet et al (WO 01/43958).

**Arguments (37 CFR 41.37(c)(1)(vii))**

All of the claims, including independent claim 1 and dependent claims 4-10, 12-13 and 16-17 are argued together.

**Argument 1 under (37 CFR 41.37(c)(1)(vii))**

The Examiner objects to claims 6-9 and 16 under 35 USC 112, second paragraph, asserting that the use of the term “groove, channel or device: is confusing, and suggests change to “void comprises”.

The Examiner objects to claims 6-9 and 16 under 35 USC 112, second paragraph, asserting that the use of the term “groove, channel or device: is confusing, and suggests change to “void comprises”. In response to the final Office Action to reduce issues on Appeal, but which response was not entered by the Examiner, Appellant deleted this term, and clarified that the insert, o-ring or plug comprises a particular shape, design, directional orientation, size, or depth, rendering this objection moot. Appellant would be willing to so amend the claims to remove this rejection. This obviousness rejection should be reversed as being in error.

**Argument 2 under (37 CFR 41.37(c)(1)(vii))**

The Examiner objects to claim 10 under 37 CFR 175(c), asserting that the claim’s adding “removable” as a dependent feature broadens the claim.

The Examiner objects to claim 10 under 37 CFR 175(c), asserting that the claim’s adding “removable” as a dependent feature broadens the claim. In response to the final Office Action to reduce issues on Appeal, but which response was not entered by the Examiner, Appellant deleted this term, rendering this rejection moot. Appellant would be willing to so amend the claims to remove this rejection. This obviousness rejection should be reversed as being in error.

**Argument 3 under (37 CFR 41.37(c)(1)(vii))**

The Examiner rejects claims 1, 4-10, 12-13 and 16-17 under 35 USC section 102 (b) as being anticipated by Great Britain 584 (GB 2,243,584).

The Examiner rejects claims 1, 4-10, 12-13 and 16-17 under 35 USC section 102 (b) as being anticipated by Great Britain 584 (GB 2,243,584). The Examiner asserts that this reference discloses a vehicle tire having grooves and removable wear indicators inserted therein, and that the wear indicator gives off an inherent scent. The Examiner asserts that Britain 584 discloses the other features of the dependent claims.

The Examiner notes that terms such as novelty, unique aroma and salient, distinctive and marketable features of the scent were deleted from claim 1. Appellant points out

that the Examiner, in the Office Action of March 14, 2006, rejected all of these terms as indefinite. Since the Examiner has now used the removal of these terms, in hindsight, to attempt to read the claims on the prior art, Appellant amended the claims to clarify that the scent or fragrance is incorporated as a scent or fragrance in a plug or insert to the vehicle tire, which claims the same invention as using the above terms which the Examiner has failed to consider patentable in claims under 35 USC 102, second paragraph. The amendments to the claims are fully supported by the priority specification, dated 4-17-03, e.g., as presented above as well as in the sentence preceding and including the first paragraph of the Description of the Invention section as follows:

Finally, a less invasive means for scenting a vehicle tire comprising a novelty plug or insert is disclosed.

#### DESCRIPTION OF THE INVENTION

The disclosed scented vehicle tire may be realized in myriad ways and combinations. Scent may be made apparent in the vehicle tire by incorporating novelty scent or fragrance in or on the rubber compound(s) comprising a given vehicle tire, in or on the any of the non-rubber components of a given tire, or on any combination of a given tire's rubber compound(s) and non-rubber components.

(Emphasis added.)

Appellant respectfully points out that the cited art fails to disclose, teach or suggest the use of an added scent or fragrance compound in a plug or insert that gives off the scent or fragrance when the vehicle tire is used but does not include the use of the scent as a tire wear indicator. The Examiner has improperly used hindsight to improperly assert that the claims are obvious over the cited references, which fail to provide any teaching or suggestion or motivation to combine or interpret the cited references to provide the claimed invention:

Appellant respectfully points out that the references in themselves do not suggest or motivate the presently claimed combination, and the Examiner has failed to show how the general knowledge suggests the combination, as required by MPEP 706.02(k) and MPEP 2143.01, which also states that "the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion

to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP sections 2143–2143.03.” The Examiner has failed to show how the references or the state of the art specifically suggest the presently claimed combination.

MPEP 2143.01 cites “*In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-8 (Fed. Cir. 1998) (the combination of the references taught every element of the claimed invention, however, without a motivation to combine, a rejection based on a *prima facie* case of obviousness was improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) . . .The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) . . .A statement that modifications of the prior art to meet the claimed invention would have been “ ‘well within the ordinary skill of the art’ at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000)

This obviousness rejection should be reversed as being in error.

**Argument 4 under (37 CFR 41.37(c)(1)(vii))**

The Examiner rejects claims 3 and 4 under 35 USC 103(a) as unpatentable over Britain 584 in view of Korea (2004029611), Japan 873 or German 356.

The Examiner rejects claims 3 and 4 under 35 USC 103(a) as unpatentable over Britain 584 in view of Korea (2004029611), Japan 873 or German 356. The presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or

friction when the tire is driven on, which invention is not suggested or taught by the cited references, alone or in combination. Additionally there is no motivation to combine the teachings of the cited references to provide the presently claimed combination. Britain 584 fails to suggest an incorporated scent or fragrance given off due to friction, use or heat and Korea's use of encapsulated fragrance as a wear indicator to be activated at the time the tire needs to be replaced does not make up the deficiencies of Britain 584. Japan 873 teaches perfume-sealed particles that are incorporated into the rubber composition of the tire and not into a plug, insert or o-ring as presently claimed. German 356 discloses a wear indicator that is activated when the tire needs to be replaced as in Japan 873 which may emit a noise, smoke or smell. German 356 fails to suggest that the "smell" can be emitted whenever the tire is exposed to normal use, as presently claimed.

Accordingly, the cited references fail to disclose, teach or suggest each and every element of the present claims. The present claims distinguish over the cited reference(s). This obviousness rejection should be reversed as being in error.

**Argument 5 under (37 CFR 41.37(c)(1)(vii))**

The Examiner rejects claims 3-11 and 13-20 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, for the reasons presented in the Office Action.

The presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or friction when the tire is driven on, which invention is not suggested or taught by the cited references, alone or in combination. Additionally there is no motivation to combine the teachings of the cited references to provide the presently claimed combination. Japan 873 teaches perfume-sealed particles that might be incorporated into the rubber composition of the tire. Japan 873 fails to teach or suggest a scent or fragrance added to a tire plug or inserts presently claimed. French 013 teaches bike tire with inner and outer non-slip tread patterns with trough that can be colored. Canada 958 discloses tire with replaceable insert to replace worn tread. Japan 908



discloses o-rings to add in the grooves between the treads to add non-black color to decorate the tire.

The presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or friction when the tire is driven on, which invention is not suggested or taught by the cited references, alone or in combination. Additionally there is no motivation to combine the teachings of the cited references to provide the presently claimed combination.

Accordingly, the cited references fail to disclose, teach or suggest each and every element of the present claims. The present claims distinguish over the cited reference(s). This obviousness rejection should be reversed as being in error.

**Argument 6 under (37 CFR 41.37(c)(1)(vii))**

The Examiner rejects claim 2 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, and further in view of Berliner, for the reasons presented in the Office Action.

The presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or friction when the tire is driven on, which invention is not suggested or taught by the cited references, alone or in combination. Additionally there is no motivation to combine the teachings of the cited references to provide the presently claimed combination. Japan 873 teaches perfume-sealed particles that might be incorporated into the rubber composition of the tire. Japan 873 fails to teach or suggest a scent or fragrance added to a tire plug or insert as presently claimed. French 013 teaches bike tire with inner and outer non-slip tread patterns with trough that can be colored. Canada 958 discloses tire with replaceable insert to replace worn tread. Japan 908 discloses o-rings to add in the grooves between the treads to add non-black color to decorate the tire. Berliner's suggestion of adding pheromone to perfume does not make up for the deficiencies of the other references and there is no suggestion in Berliner to combine its teaches for use in a scented tire.

Accordingly, the cited references fail to disclose, teach or suggest each and every element of the present claims. The present claims distinguish over the cited reference(s). This obviousness rejection should be reversed as being in error.

**Argument 7 under (37 CFR 41.37(c)(1)(vii))**

The Examiner rejects claims 4 and 13 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, and further in view of Berliner, for the reasons presented in the Office Action.

The presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or friction when the tire is driven on, which invention is not suggested or taught by the cited references, alone or in combination. Additionally there is no motivation to combine the teachings of the cited references to provide the presently claimed combination. Japan 873 teaches perfume-sealed particles that might be incorporated into the rubber composition of the tire. Japan 873 fails to teach or suggest a scent or fragrance added to a tire plug or insert as presently claimed. French 013 teaches bike tire with inner and outer non-slip tread patterns with trough that can be colored. Canada 958 discloses tire with replaceable insert to replace worn tread. Japan 908 discloses o-rings to add in the grooves between the treads to add non-black color to decorate the tire. French 340 suggesting (according to the Examiner) colored o-rings or grooves for a particular color scheme or colored rubber or tearable cell wear indicator (not presently claimed) fails to make up for the deficiencies of the primary references.

Accordingly, the cited references fail to disclose, teach or suggest each and every element of the present claims. The present claims distinguish over the cited reference(s). This obviousness rejection should be reversed as being in error.

**Argument 8 under (37 CFR 41.37(c)(1)(vii))**

The Examiner rejects claim 12 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, and further in view of Mellet et al (WO 01/43958), for the reasons presented in the Office Action.

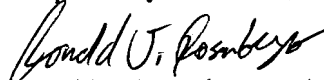
The presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or friction when the tire is driven on, which invention is not suggested or taught by the cited references, alone or in combination. Additionally there is no motivation to combine the teachings of the cited references to provide the presently claimed combination. Japan 873 teaches perfume-sealed particles that might be incorporated into the rubber composition of the tire. Japan 873 fails to teach or suggest a scent or fragrance added to a tire plug or insert as presently claimed. French 013 teaches bike tire with inner and outer non-slip tread patterns with trough that can be colored. Canada 958 discloses tire with replaceable insert to replace worn tread. Japan 908 discloses o-rings to add in the grooves between the treads to add non-black color to decorate the tire. Mellet et al teaches colored covers that fit into grooves between tread of a bike tire. Mellet fails to make up for the deficiencies of the other references.

Accordingly, the cited references fail to disclose, teach or suggest each and every element of the present claims. The present claims distinguish over the cited reference(s). This obviousness rejection should be reversed as being in error.

**Conclusion**

In view of the above arguments and evidence of record, Appellants request that the Examiner's rejections be reversed and the case remanded to the Examiner for allowance.

Respectfully submitted,



Ronald J. Rosenberger, Appellant  
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**Date: November INSERT, 2007**

**CLAIMS ON APPEAL**

1. (Previously Amended) A vehicle tire, comprising at least one removable insert, o-ring or plug provided in at least one void contained adjacent to the outside surface of at least one of a tread, a belt or a ply of said vehicle tire, said insert, o-ring or plug comprising at least one scent or fragrance that is released when said tire is used in a vehicle for driving, said release of said scent or fragrance due to friction, heat buildup, or wear.
2. (Previously Amended) The vehicle tire of claim 1, wherein said at least one insert, o-ring or plug further comprises.
4. (Previously Amended) The vehicle tire of claim 1, wherein said vehicle tire further comprises at least one wear warning component comprising at least one of a wear warning scent, visible wear warning non-colored or colored smoke, or visible wear warning powder that optionally leaves a residue, wherein the intensity or timing of the release of said wear warning component is proportional to the wear level of said vehicle tire.
5. (Previously Amended) The vehicle tire of claim 1, wherein said insert, o-ring or plug is color coordinated with said scent or fragrance, or wherein the color of said insert, o-ring or plug is incongruous with said scent or fragrance.
6. (Previously Amended) The vehicle tire of claim 1, wherein said void, insert, o-ring or plug comprises a particular shape, design, directional orientation, size, or depth, or a groove, channel, or crevice.
7. (Previously Amended) The vehicle tire of claim 6, wherein said vehicle tire further comprises at least one void anywhere on the outside surface of said tire, said void providing for placement or replacement of at least one additional insert, o-ring or plug comprising at least one of a fragrance, a scent, a pheromone or a wear warning component.
8. (Previously Amended) The vehicle tire of claim 6, wherein said vehicle tire is selected from a vehicle tire for at least one of an automobile, a sport utility vehicle, a minivan; a heavy machinery work vehicle, a truck, a farm equipment vehicle, an aircraft; a bus; a motorcycle, a scooters, a motorbike; an all-terrain vehicle, a golf cart, a go cart; a bicycle, a unicycle, a tricycles, or an exercise bike.

9. (Previously Amended) The vehicle tire of claim 6, wherein at least one of said at least one void can accommodate two or more of at least one of said plug, o-ring or insert.
10. (Previously Amended) The vehicle tire of claim 1, wherein said plug, o-ring or insert:
- comprises at least one color
  - is inserted, installed or secured in said void
  - is removable from said at least one void of said vehicle tire; or
  - comprises an embodiment of an "O" ring around the circumference or diameter of said vehicle tire.
12. (Previously Amended) The vehicle tire of claim 1, wherein said insert, o-ring or plug further comprises at least one visual aspect selected from a reflective component, a refractive component, a sparkling component, a shining component, a holographic component, a jewel-like component, a luminescent component, a pearlescent component, a fluorescent component, or a glow-in-the dark component.
13. (Previously Amended) The vehicle tire of claim 4, wherein said wear warning component comprises at least one wear warning plug, o-ring or insert is oriented in said vehicle tire such that deployment occurs at a predetermined level of wear of said vehicle tire, and wherein said wear warning plug, o-ring or insert comprises: 1) at least one wear warning composition comprising at least one wear warning scent, visible wear warning colored or non-colored smoke, or wear warning powder; or, 2) at least one capsules or microcapsule comprising said at least one wear warning composition, said capsule or microcapsule rupturing with exposure due to wear, thereby releasing said wear warning composition, wherein the level of said release of said wear warning composition is proportional to the wear level of said vehicle tire.
16. (Previously Amended) The vehicle tire of claim 7, comprising wherein said plug, o-ring or insert, provided for placement in said void, comprises semi-solids that are introduced into said void using at least one method selected from pouring, pumping, injecting, or spraying.
17. (Previously Amended) The vehicle tire of claim 1, wherein said plug, o-ring or insert comprises two or more sections, wherein at least one said at least one

color; at least one scent or fragrance; at least one pheromone; at least one visual aspect; or at least one wear warning component.

**Evidence Appendix Under 41.37(c)(1)(ix)**

NONE.

There is no related evidence under 37 C.F.R. 1.130, 1.131, or 1.132 being filed with this Brief on Appeal.

**Related Proceedings Appendix Under 41.37(c)(1)(x)**

NONE.

There are no related proceedings pursuant to 41.37(c)(1)(ii).





Application No. 10/822,049

Art Unit: 1733

Request for reconsideration to Remand Appeal Brief

November 13, 2007

**BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: RONALD JOHN ROSENBERGER  
Application No.: 10/822,049 Art. Unit: 1733  
Filing Date: 04/10/2004 Examiner: Steven D. Maki

Title: **SCENTED TIRES**

I hereby certify that this correspondence is being deposited with the  
United States Postal Service as first class mail in an envelope addressed  
to: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

November 13, 2007

(Date of Deposit)

**Ronald J. Rosenberger**

(Name of applicant, assignee, or Registered Representative)

(Signature)

November 13, 2007

(Date of Signature)

**Commissioner for Patents**

P. O. Box: 1450

Alexandria, VA 22313-1450

**Attn: MAIL STOP APPEAL**

**REQUEST FOR RECONSIDERATION TO REMAND APPLICATION IN  
VIEW OF EXAMINER'S:**

- (1) **MAKING NEW GROUNDS OF REJECTION UNDER FINAL OFFICE ACTION;**
- (2) **FAILURE TO REMOVE NON-FINAL STATUS OF OFFICE ACTION WITH NEW GROUNDS OF REJECTION;**
- (3) **FAILURE TO ENTER AMENDMENT IN RESPONSE TO NEW GROUNDS OF REJECTION**
- (4) **FAILURE TO ALLOW ENTRY OF RESPONSE TO NEW GROUNDS OF REJECTION ON APPEAL; AND**
- (5) **ASSERTING THAT FAILURE TO ALLOW ENTRY OF RESPONSE TO NEW GROUNDS OF REJECTION ON APPEAL CONSTITUTES APPELLANT'S ADMISSION OF UNPATENTABILITY OF APPEALED CLAIMS**

Dear Sir:

Applicant-Appellant files this Request for Reconsideration, based on the following remarks, in conjunction with the response to the Notice of Non-Compliant Appeal Brief, mailed October 16, 2007, which is submitted herewith, in conjunction with the submitted and timely Notice of Appeal filed on December 8, 2006 and Brief on Appeal, filed February 8, 2007, Applicant-Appellant submits the following Corrected Brief on Appeal under 37 CFR 41.37, now due November 16, 2007, in response to the Notice of Non-Compliant Appeal Brief, mailed October 16, 2007.

### **REMARKS**

Appellant-Applicant requests reconsideration by the Board of Appeals to have the pending appeal remanded to the Examiner for one or all of the following bases:

- (1) making new grounds of rejection under 102(b) and 103(b) using newly cited art (GB2,243,584) in the Final Office Action dated September 8, 2006,
- (2) failing to withdraw the finality of the Final Office Action as requested by Appellant on page 5 of the Amendment and Response filed December 8, 2006, and
- (3) failing to enter the Amendment and Response, dated December 8, 2006, including amendments to the claims and new arguments to address the new grounds of rejection; and
- (4) on Appeal, failing to allow or enter arguments in response to address the new grounds of rejection;
- (5) on Appeal, by Examiner's failing to allow or enter arguments in response to address the new grounds of rejection, the Examiner characterizes such failed entry as amounting to an admission by Appellant that the claims presented before the new grounds of rejection in the final office action lack novelty and obviousness under the new grounds of rejection.

In the Notice of Non-Compliant Amendment Appeal Brief, dated October 16, 2007, in the pending Appeal, the Examiner has requested "corrections" to the Appeal Brief by Applicant-Appellant arguing that since some arguments were presented that were made

to a new ground of rejection in the after final Response filed December 8, 2006, but not entered by the Examiner, and such arguments made in Appeal Brief are not Admissible.

However, the Examiner fails to point out or acknowledge that, since the Examiner made new made grounds of rejection in the Final Office Action dated September 8, 2006 over newly cited reference GB 2,243,584 under 102(b) and 103(a) of pending claims 1, 4-10, 12-13 and 16-17, which constituted a new ground of rejection first presented by the Examiner in the Final Office Action, Applicant did not have any other opportunity to present any claim amendments or arguments to those new rejections until the Appeal Brief. This is because the Examiner failed to allow entry of the Response filed December 8, 2006.

Accordingly, if the Examiner made new rejections in the Final Office Action, did not remove the finality of the Final Office Action, and then did not enter Appellant-Applicant's claim amendments and response to those new rejections in response to the Final Office Action in the Advisory Action, Applicant-Appellant's only opportunity to respond to the new rejections was in the Appeal Brief.

Applicant-Appellant requests reconsideration by the Patent Office and the Board of Appeals to remand this Appeal to the Examiner for the opportunity for Appellant to amend the claims and respond to the new grounds of rejection made in the final Office Action dated September 8, 2006. This is because the Examiner has not followed the MPEP and 37 CFR, and the Examiner has prevented Applicant-Appellant from either amending the claims or responding to the new grounds of rejection. Applicant-Appellant also submits that the Examiner has abused his discretion by, after refusing to let Applicant-Appellant amend the claims or respond to the new grounds of rejection, the Examiner then asserts that Applicant-Appellant has admitted that that newly cited art renders the pending claims to lack novelty and to be obvious!

Appellants provide the following details in support of each of the request for reconsideration grounds or remanding this application to the Examiner for further prosecution under the new grounds of rejection.

**(1) Making new grounds of rejection under 102(b) and 103(b) using newly cited art (GB 2,243,584) in the Final Office Action dated September 8, 2006.**

In the non-final Office Action dated March 14, 2006, the Examiner made prior art rejections of claims 1-20 under 102(a), (b) and 103(a) over JP 2002-114873 or JP 7-69003, in view of US5278141, 6220199, US2272981, JP 11-151908, FR 1498340, or further in view of KR 2004 029611. The Examiner did not make any rejections over any other references. In response, Appellants made clarifying amendments to claims 1, 4-10, 12-13 and 16-17 and canceled the remaining claims to further prosecution.

In the Final Office Action, the Examiner made a whole new set of rejections of all of the remaining claims under 102(b) and 103(a), newly citing GB 2,234,584, and further in view of KR 2004 029611, JP 2002-114873, DE 2949356, making one new rejection under 102(b) and one new rejection under 103(b).

The Examiner also repeated the rejections under 102(b) and 103(a) over JP 2002-114873, repeating the arguments made in the prior office action.

In response to the new grounds of rejection, Appellants filed a Response and Amendment dated December 8, 2006, requesting withdrawal of the finality of the Office Action and clarifying and distinguishing the claims over the cited references.

**(2) Failing to withdraw the finality of the Final Office Action as requested by Appellant on page 5 of the Amendment and Response filed December 8, 2006.**

In response to the new grounds of rejection, Appellants filed a Response and Amendment dated December 8, 2006, requesting withdrawal of the finality of the Office Action and clarifying and distinguishing the claims over the cited references:

**“REMARKS**

**Applicant requests that the final status of the present Office Action be removed, due to the fact that the Examiner has made new prior art rejections using different art and different combinations of art.”**

In the Advisory Action mailed January 4, 2007, the Examiner failed to withdraw the finality of the Final Office Action dated June 16, 2006, asserting that deletion of parts of claim 1 were deemed to be “extensive amendments” that “simultaneously broadened and narrowed claim 1, which was not part of the original dependent claims.” The Examiner also asserted that the amended claim 1 now newly read on natural scent.

However, the reasons made by the Examiner are not supported by the rejections and claim characterizations made by the Examiner. The Examiner continued to make 112 rejections of the use of the terms relating to fragrance added to the tires which resulted in Appellants amending the claims as suggested by the Examiner, and which did not read on natural scent of the tire, where the amended claims recited that a fragrance was incorporated into the insert, o-ring or plug and release upon use of the tire. This language excludes the Examiner’s characterization that the claims read on any natural scent of the tires. Accordingly the Examiner’s characterization of such “broadening” is incorrect.

Additionally the Examiner continued to make the same rejections of the claims using the same art as the prior non-final Office Action, such that the Examiner’s assertion that the claims amendments necessitated the new grounds of rejection is not supported by the record.

Accordingly, the Examiner should have properly removed the finality of the final office action dated September 8, 2006.

- (3) Failing to enter the Amendment and Response, dated December 8, 2006, including amendments to the claims and new arguments to address the new grounds of rejection**

When the Examiner did not remove the finality of the final office action and did site new art and made new rejections, then the Examiner should have entered the Response and Amendment to address the new ground of rejection, if only to provide an opportunity for Appellants to respond to the new grounds of rejection.

Accordingly, the Examiner should have properly entered the Response and Amendment field December 8, 2006.

**(4) On Appeal, failing to allow or enter arguments in response to address the new grounds of rejection.**

When the Examiner did enter the Response and Amendment filed December 8, 2006, to address the new ground of rejection, then Appellant must be given the opportunity to respond to the new grounds of rejection in the Appeal Brief as that is the only opportunity to do so.

Accordingly, the Examiner should have properly allowed the arguments entered the Appeal Brief February 5, 2007.

**(5) On Appeal, by Examiner's failing to allow or enter arguments in response to address the new grounds of rejection, the Examiner characterizes such failed entry as amounting to an admission by Appellant that the claims presented before the new grounds of rejection in the final office action lack novelty and obviousness under the new grounds of rejection.**

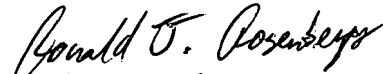
Applicant-Appellant also submits that the Examiner has abused his discretion by, after refusing to let Applicant-Appellant amend the claims or respond to the new grounds of rejection, the Examiner then asserts that Applicant-Appellant has admitted that that newly cited art renders the pending claims to lack novelty and to be obvious!

The Examiner has thus made new grounds of rejection, not allowed the Appellant to respond in either the Response to the final Office Action or the Appeal Brief, and then holds that after not allowing Appellant to address or respond to the new grounds of rejection, deeming such "non-response" to be an admission of lack of patentability of the claims of the new grounds of cited art that Appellant is not allowed to respond to.

**Conclusion**

In view of the above arguments and evidence of record, Appellants request that the case remanded to the Examiner for further consideration to let Appellants respond to the new grounds of rejection.

Respectfully submitted,



Ronald J. Rosenberger

Applicant

ronrosenberger@hotmail.com

(215) 579-9871

**Date: November 13, 2007**



**BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellant: RONALD JOHN ROSENBERGER  
Application No.: 10/822,049 Art. Unit: 1733  
Filing Date: 04/10/2004 Examiner: Steven D. Maki

Title: **SCENTED TIRES**

I hereby certify that this correspondence is being deposited with the  
United States Postal Service as first class mail in an envelope addressed  
to: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on  
November 13, 2007

(Date of Deposit)

**Ronald J. Rosenberger**

(Name of Appellant, assignee, or Registered Representative)

(Signature)

November 13, 2007

(Date of Signature)

**Commissioner for Patents**  
P. O. Box: 1450  
Alexandria, VA 22313-1450

**Attn: MAIL STOP APPEAL**

**APPELLANT'S CORRECTED BRIEF ON APPEAL UNDER 37 CFR 41.37**

Dear Sir:

In conjunction with the submitted and timely Notice of Appeal filed on December 8, 2006 and Brief on Appeal, filed February 8, 2007, Appellant submits the following Corrected Brief on Appeal under 37 CFR 41.37, now due November 16, 2007, in response to the Notice of Non-Compliant Appeal Brief, mailed October 16, 2007.

Appellant points out that, contrary to the statements made by the Examiner, that this Appeal Brief includes arguments for each ground of rejection, including new grounds of rejection made in the final Office Action dated September 8, 2006, which Response was not entered by the Examiner, and for which the Appeal Brief can provide such responses as required by MPEP1205.02.



The Examiner citing of MPEP 1205.02 is therefore misplaced for adding “new or non-admitted amendment, affidavit, or other evidence” which section of the MPEP does not include arguments or “language” and for which the Appellant is entitled to make such arguments, especially for addressing new grounds of rejection that Appellants had responded to, but which the Examiner did not enter and for which the Appeal Brief is the only place for Appellants to address.

Additionally Appellants point out that, also contrary to the Examiner, the prior and current Appeal Brief includes, inter alias, a statement of the status of the claims under 37 CFR.37(c)(1)(iii) (Page 3), a statement of the status of each amendment under 37 CFR.37(c)(1)(iv) (Page 3), a concise statement of each ground of rejection under 37 CFR.37(c)(1)(vi) (Page 4), an argument under separate heading for each ground of rejection on appeal under 37 CFR.37(c)(1)(vii) (Pages 5-12), and a correct copy of the appealed claims under 37 CFR.37(c)(1)(viii) (Appendix A).

Appellant also submits that the Examiner has abused his discretion by, after refusing to let Applicant-Appellant amend the claims or respond to the new grounds of rejection, the Examiner then asserts that Applicant-Appellant has admitted that that newly cited art renders the pending claims to lack novelty and to be obvious!

**Real Party in Interest (37 CFR 41.37(c)(1)(i))**

The Appellant-inventor, Ronald Rosenberger is the owner of entire interest in the above-identified patent application as the sole Appellant, and which interest has not been assigned.

**Related Appeals and Interferences (37 CFR 41.37(c)(1)(ii))**

There are no related appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal and accordingly there are no decisions to provide copies herewith.

**Status of Claims (37 CFR 41.37(c)(1)(iii))**

Pending original and previously amended claims 1-2, 4-10, 12-13 and 16-17 including independent claim 1, all stand rejected and are on appeal. Claims 3, 11, 14-15 were previously canceled.

**Status of Amendments (37 CFR 41.37(c)(1)(iv))**

The Examiner did not enter an Amendment under 37 CFR 116, mailed on December 08, 2006, in response to the final Office Action mailed September 8, 2006, as indicated in an Advisory Action of record. The Examiner maintained his rejections as indicated in the Advisory Action. Accordingly, the claims stand for the present Appeal in the form they were amended and canceled in the Amendment and Response filed June 14, 2006 to the Office Action of March 14, 2006.

**Summary of Claimed Subject Matter (37 CFR 41.37(c)(1)(v))**

Pending claims 1-2, 4-10, 12-13 and 16-17 cover particular aspect of the present invention, which provides, e.g., in claim 1, a vehicle tire comprising voids comprising removable inserts, o-rings or plugs that comprise at least one scent or fragrance that is released by friction, heat or wear when the vehicle with the vehicle tire is driven. The following table provides each independent claim and its corresponding support in the specification.

<b><u>Independent claim</u></b>	<b><u>Specification Support</u></b>
1. A vehicle tire, comprising at least one removable insert, o-ring or plug provided in at least one void contained adjacent to the outside surface of at least one of a tread, a belt or a ply of said vehicle tire, said insert,	Claim 1 as filed: A vehicle tire comprising at least one novelty scented rubber compound, and/or at least one novelty scented non-rubber component, where said novelty scented rubber compound and/or said novelty scented component comprises at least one novelty scent or fragrance, where said novelty scented rubber compound and/or said novelty scented non-rubber component gives off a unique aroma when said tire is at rest, where said novelty scented rubber compound and/or said novelty scented non-rubber component gives off a unique aroma when said tire is in normal use due to friction, heat buildup, and wear; and where normal wear of said vehicle tire exposes fresh surface area of said novelty scented rubber compound, and/or said novelty scented non-rubber component, wherein said unique aroma comprises a salient,

<p>o-ring or plug comprising at least one that is released when said tire is <del>in normal</del> used in a vehicle for driving, said release of said scent or fragrance due to friction, heat buildup, or wear.</p>	<p>distinctive, and marketable feature of said vehicle tire.</p> <p>(Page 13, 2<sup>nd</sup> full paragraph) The novelty plug or insert is intended to be installable on the outside surface of a tire. While theoretically the novelty plug or insert should be installable anywhere on the outside surface of the tire, it is apparent that the most optimal situation would place the novelty plug or insert comprising erodible material in the tread of the tire, with the novelty plug or insert exposed and visible on the tire's tread. Such an embodiment would permit friction and heat build-up, as well as wear, that would stimulate the release of the novelty scent or fragrance. For this reason, it is preferred that the outside surface of the novelty plug or insert be flush with the outside tire surface, and not be recessed in any way. The novelty plug or insert can be installed on the disclosed vehicle tire that comprises novelty scented rubber compound and/or novelty scented non-rubber component, and/or pheromones, and/or wear warning oriented rubber compound and/or wear warning oriented non-rubber components, or it may be installed on tires that do not comprise any one or all of the abovementioned attributes</p> <p>(Page 14, first full paragraph) The novelty plug or insert can comprise any shape, design, size or depth. For example, the novelty plug or insert may appear in the tire as being circular in shape, a quarter inch wide and a quarter inch deep; or, shaped like the State of Texas, an inch across; or, can comprise a lined design, such as a Celtic symbol an inch and a half high. Also, the novelty plug or insert can comprise any embodiment of an "O" ring around the tread circumference or tire wall diameter of the vehicle tire. Also, a given "O" ring could even be elastic or semi-elastic, and perhaps have qualities similar to a rubber band or an elastic hair band that can be stretched on or off the tire, and can be easily replaced at will.</p>
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**Grounds of Rejection to be reviewed on Appeal (37 CFR 41.37(c)(1)(vi))**

1. The Examiner objects to claims 6-9 and 16 under 35 USC 112, second paragraph, asserting that the use of the term “groove, channel or device: is confusing, and suggests change to “void comprises”.
2. The Examiner objects to claim 10 under 37 CFR 175(c), asserting that the claim’s adding “removable” as a dependent feature broadens the claim.
3. The Examiner rejects claims 1, 4-10, 12-13 and 16-17 under 35 USC section 102 (b) as being anticipated by Great Britain 584 (GB 2,243,584).
4. The Examiner rejects claims 3 and 4 under 35 USC 103(a) as unpatentable over Britain 584 in view of Korea (2004029611), Japan 873 or German 356
5. The Examiner rejects claims 3-11 and 13-20 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908.
6. The Examiner rejects claim 2 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, and further in view of Berliner
7. The Examiner rejects claims 4 and 13 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, and further in view of Berliner
8. The Examiner rejects claim 12 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, and further in view of Mellet et al (WO 01/43958).

**Arguments (37 CFR 41.37(c)(1)(vii))**

All of the claims, including independent claim 1 and dependent claims 4-10, 12-13 and 16-17 are argued together.

**Argument 1 under (37 CFR 41.37(c)(1)(vii))**

The Examiner objects to claims 6-9 and 16 under 35 USC 112, second paragraph, asserting that the use of the term “groove, channel or device: is confusing, and suggests change to “void comprises”.

The Examiner objects to claims 6-9 and 16 under 35 USC 112, second paragraph, asserting that the use of the term “groove, channel or device: is confusing, and suggests change to “void comprises”. In response to the final Office Action to reduce issues on Appeal, but which response was not entered by the Examiner, Appellant deleted this term, and clarified that the insert, o-ring or plug comprises a particular shape, design, directional orientation, size, or depth, rendering this objection moot. Appellant would be willing to so amend the claims to remove this rejection. This obviousness rejection should be reversed as being in error.

**Argument 2 under (37 CFR 41.37(c)(1)(vii))**

The Examiner objects to claim 10 under 37 CFR 175(c), asserting that the claim’s adding “removable” as a dependent feature broadens the claim.

The Examiner objects to claim 10 under 37 CFR 175(c), asserting that the claim’s adding “removable” as a dependent feature broadens the claim. In response to the final Office Action to reduce issues on Appeal, but which response was not entered by the Examiner, Appellant deleted this term, rendering this rejection moot. Appellant would be willing to so amend the claims to remove this rejection. This obviousness rejection should be reversed as being in error.

**Argument 3 under (37 CFR 41.37(c)(1)(vii))**

The Examiner rejects claims 1, 4-10, 12-13 and 16-17 under 35 USC section 102 (b) as being anticipated by Great Britain 584 (GB 2,243,584).

The Examiner rejects claims 1, 4-10, 12-13 and 16-17 under 35 USC section 102 (b) as being anticipated by Great Britain 584 (GB 2,243,584). The Examiner asserts that this reference discloses a vehicle tire having grooves and removable wear indicators inserted therein, and that the wear indicator gives off an inherent scent. The Examiner asserts that Britain 584 discloses the other features of the dependent claims.

The Examiner notes that terms such as novelty, unique aroma and salient, distinctive and marketable features of the scent were deleted from claim 1. Appellant points out

that the Examiner, in the Office Action of March 14, 2006, rejected all of these terms as indefinite. Since the Examiner has now used the removal of these terms, in hindsight, to attempt to read the claims on the prior art, Appellant amended the claims to clarify that the scent or fragrance is incorporated as a scent or fragrance in a plug or insert to the vehicle tire, which claims the same invention as using the above terms which the Examiner has failed to consider patentable in claims under 35 USC 102, second paragraph. The amendments to the claims are fully supported by the priority specification, dated 4-17-03, e.g., as presented above as well as in the sentence preceding and including the first paragraph of the Description of the Invention section as follows:

Finally, a less invasive means for scenting a vehicle tire comprising a novelty plug or insert is disclosed.

#### DESCRIPTION OF THE INVENTION

The disclosed scented vehicle tire may be realized in myriad ways and combinations. Scent may be made apparent in the vehicle tire by incorporating novelty scent or fragrance in or on the rubber compound(s) comprising a given vehicle tire, in or on the any of the non-rubber components of a given tire, or on any combination of a given tire's rubber compound(s) and non-rubber components.

(Emphasis added.)

Appellant respectfully points out that the cited art fails to disclose, teach or suggest the use of an added scent or fragrance compound in a plug or insert that gives off the scent or fragrance when the vehicle tire is used but does not include the use of the scent as a tire wear indicator. The Examiner has improperly used hindsight to improperly assert that the claims are obvious over the cited references, which fail to provide any teaching or suggestion or motivation to combine or interpret the cited references to provide the claimed invention:

Appellant respectfully points out that the references in themselves do not suggest or motivate the presently claimed combination, and the Examiner has failed to show how the general knowledge suggests the combination, as required by MPEP 706.02(k) and MPEP 2143.01, which also states that "the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion

to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP sections 2143–2143.03." The Examiner has failed to show how the references or the state of the art specifically suggest the presently claimed combination.

MPEP 2143.01 cites "*In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-8 (Fed. Cir. 1998) (the combination of the references taught every element of the claimed invention, however, without a motivation to combine, a rejection based on a *prima facie* case of obviousness was improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) . . . The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) . . . A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art ' at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000)

This obviousness rejection should be reversed as being in error.

**Argument 4 under (37 CFR 41.37(c)(1)(vii))**

The Examiner rejects claims 3 and 4 under 35 USC 103(a) as unpatentable over Britain 584 in view of Korea (2004029611), Japan 873 or German 356.

The Examiner rejects claims 3 and 4 under 35 USC 103(a) as unpatentable over Britain 584 in view of Korea (2004029611), Japan 873 or German 356. The presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or

friction when the tire is driven on, which invention is not suggested or taught by the cited references, alone or in combination. Additionally there is no motivation to combine the teachings of the cited references to provide the presently claimed combination. Britain 584 fails to suggest an incorporated scent or fragrance given off due to friction, use or heat and Korea's use of encapsulated fragrance as a wear indicator to be activated at the time the tire needs to be replaced does not make up the deficiencies of Britain 584. Japan 873 teaches perfume-sealed particles that are incorporated into the rubber composition of the tire and not into a plug, insert or o-ring as presently claimed. German 356 discloses a wear indicator that is activated when the tire needs to be replaced as in Japan 873 which may emit a noise, smoke or smell. German 356 fails to suggest that the "smell" can be emitted whenever the tire is exposed to normal use, as presently claimed.

Accordingly, the cited references fail to disclose, teach or suggest each and every element of the present claims. The present claims distinguish over the cited reference(s). This obviousness rejection should be reversed as being in error.

**Argument 5 under (37 CFR 41.37(c)(1)(vii))**

The Examiner rejects claims 3-11 and 13-20 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, for the reasons presented in the Office Action.

The presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or friction when the tire is driven on, which invention is not suggested or taught by the cited references, alone or in combination. Additionally there is no motivation to combine the teachings of the cited references to provide the presently claimed combination. Japan 873 teaches perfume-sealed particles that might be incorporated into the rubber composition of the tire. Japan 873 fails to teach or suggest a scent or fragrance added to a tire plug or inserts presently claimed. French 013 teaches bike tire with inner and outer non-slip tread patterns with trough that can be colored. Canada 958 discloses tire with replaceable insert to replace worn tread. Japan 908



discloses o-rings to add in the grooves between the treads to add non-black color to decorate the tire.

The presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or friction when the tire is driven on, which invention is not suggested or taught by the cited references, alone or in combination. Additionally there is no motivation to combine the teachings of the cited references to provide the presently claimed combination.

Accordingly, the cited references fail to disclose, teach or suggest each and every element of the present claims. The present claims distinguish over the cited reference(s). This obviousness rejection should be reversed as being in error.

**Argument 6 under (37 CFR 41.37(c)(1)(vii))**

The Examiner rejects claim 2 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, and further in view of Berliner, for the reasons presented in the Office Action.

The presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or friction when the tire is driven on, which invention is not suggested or taught by the cited references, alone or in combination. Additionally there is no motivation to combine the teachings of the cited references to provide the presently claimed combination. Japan 873 teaches perfume-sealed particles that might be incorporated into the rubber composition of the tire. Japan 873 fails to teach or suggest a scent or fragrance added to a tire plug or insert as presently claimed. French 013 teaches bike tire with inner and outer non-slip tread patterns with trough that can be colored. Canada 958 discloses tire with replaceable insert to replace worn tread. Japan 908 discloses o-rings to add in the grooves between the treads to add non-black color to decorate the tire. Berliner's suggestion of adding pheromone to perfume does not make up for the deficiencies of the other references and there is no suggestion in Berliner to combine its teaches for use in a scented tire.

Accordingly, the cited references fail to disclose, teach or suggest each and every element of the present claims. The present claims distinguish over the cited reference(s). This obviousness rejection should be reversed as being in error.

**Argument 7 under (37 CFR 41.37(c)(1)(vii))**

The Examiner rejects claims 4 and 13 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, and further in view of Berliner, for the reasons presented in the Office Action.

The presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or friction when the tire is driven on, which invention is not suggested or taught by the cited references, alone or in combination. Additionally there is no motivation to combine the teachings of the cited references to provide the presently claimed combination. Japan 873 teaches perfume-sealed particles that might be incorporated into the rubber composition of the tire. Japan 873 fails to teach or suggest a scent or fragrance added to a tire plug or insert as presently claimed. French 013 teaches bike tire with inner and outer non-slip tread patterns with trough that can be colored. Canada 958 discloses tire with replaceable insert to replace worn tread. Japan 908 discloses o-rings to add in the grooves between the treads to add non-black color to decorate the tire. French 340 suggesting (according to the Examiner) colored o-rings or grooves for a particular color scheme or colored rubber or tearable cell wear indicator (not presently claimed) fails to make up for the deficiencies of the primary references.

Accordingly, the cited references fail to disclose, teach or suggest each and every element of the present claims. The present claims distinguish over the cited reference(s). This obviousness rejection should be reversed as being in error.

**Argument 8 under (37 CFR 41.37(c)(1)(vii))**

The Examiner rejects claim 12 under 35 USC 103(a) as unpatentable over Japan 873, in view of one of French 013, Canada 958 or Japan 908, and further in view of Mellet et al (WO 01/43958), for the reasons presented in the Office Action.

The presently claimed invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or friction when the tire is driven on, which invention is not suggested or taught by the cited references, alone or in combination. Additionally there is no motivation to combine the teachings of the cited references to provide the presently claimed combination. Japan 873 teaches perfume-sealed particles that might be incorporated into the rubber composition of the tire. Japan 873 fails to teach or suggest a scent or fragrance added to a tire plug or insert as presently claimed. French 013 teaches bike tire with inner and outer non-slip tread patterns with trough that can be colored. Canada 958 discloses tire with replaceable insert to replace worn tread. Japan 908 discloses o-rings to add in the grooves between the treads to add non-black color to decorate the tire. Mellet et al teaches colored covers that fit into grooves between tread of a bike tire. Mellet fails to make up for the deficiencies of the other references.

Accordingly, the cited references fail to disclose, teach or suggest each and every element of the present claims. The present claims distinguish over the cited reference(s). This obviousness rejection should be reversed as being in error.

**Conclusion**

In view of the above arguments and evidence of record, Appellants request that the Examiner's rejections be reversed and the case remanded to the Examiner for allowance.

Respectfully submitted,



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**Date: November INSERT, 2007**

**CLAIMS ON APPEAL**

1. (Previously Amended) A vehicle tire, comprising at least one removable insert, o-ring or plug provided in at least one void contained adjacent to the outside surface of at least one of a tread, a belt or a ply of said vehicle tire, said insert, o-ring or plug comprising at least one scent or fragrance that is released when said tire is used in a vehicle for driving, said release of said scent or fragrance due to friction, heat buildup, or wear.
2. (Previously Amended) The vehicle tire of claim 1, wherein said at least one insert, o-ring or plug further comprises.
4. (Previously Amended) The vehicle tire of claim 1, wherein said vehicle tire further comprises at least one wear warning component comprising at least one of a wear warning scent, visible wear warning non-colored or colored smoke, or visible wear warning powder that optionally leaves a residue, wherein the intensity or timing of the release of said wear warning component is proportional to the wear level of said vehicle tire.
  5. (Previously Amended) The vehicle tire of claim 1, wherein said insert, o-ring or plug is color coordinated with said scent or fragrance, or wherein the color of said insert, o-ring or plug is incongruous with said scent or fragrance.
  6. (Previously Amended) The vehicle tire of claim 1, wherein said void, insert, o-ring or plug comprises a particular shape, design, directional orientation, size, or depth, or a groove, channel, or crevice.
  7. (Previously Amended) The vehicle tire of claim 6, wherein said vehicle tire further comprises at least one void anywhere on the outside surface of said tire, said void providing for placement or replacement of at least one additional insert, o-ring or plug comprising at least one of a fragrance, a scent, a pheromone or a wear warning component.
  8. (Previously Amended) The vehicle tire of claim 6, wherein said vehicle tire is selected from a vehicle tire for at least one of an automobile, a sport utility vehicle, a minivan; a heavy machinery work vehicle, a truck, a farm equipment vehicle, an aircraft; a bus; a motorcycle, a scooters, a motorbike; an all-terrain vehicle, a golf cart, a go cart; a bicycle, a unicycle, a tricycles, or an exercise bike.

9. (Previously Amended) The vehicle tire of claim 6, wherein at least one of said at least one void can accommodate two or more of at least one of said plug, o-ring or insert.
10. (Previously Amended) The vehicle tire of claim 1, wherein said plug, o-ring or insert:
- a. comprises at least one color
  - b. is inserted, installed or secured in said void
  - c. is removable from said at least one void of said vehicle tire; or
  - d. comprises an embodiment of an "O" ring around the circumference or diameter of said vehicle tire.
12. (Previously Amended) The vehicle tire of claim 1, wherein said insert, o-ring or plug further comprises at least one visual aspect selected from a reflective component, a refractive component, a sparkling component, a shining component, a holographic component, a jewel-like component, a luminescent component, a pearlescent component, a fluorescent component, or a glow-in-the dark component.
13. (Previously Amended) The vehicle tire of claim 4, wherein said wear warning component comprises at least one wear warning plug, o-ring or insert is oriented in said vehicle tire such that deployment occurs at a predetermined level of wear of said vehicle tire, and wherein said wear warning plug, o-ring or insert comprises: 1) at least one wear warning composition comprising at least one wear warning scent, visible wear warning colored or non-colored smoke, or wear warning powder; or, 2) at least one capsules or microcapsule comprising said at least one wear warning composition, said capsule or microcapsule rupturing with exposure due to wear, thereby releasing said wear warning composition, wherein the level of said release of said wear warning composition is proportional to the wear level of said vehicle tire.
16. (Previously Amended) The vehicle tire of claim 7, comprising wherein said plug, o-ring or insert, provided for placement in said void, comprises semi-solids that are introduced into said void using at least one method selected from pouring, pumping, injecting, or spraying.
17. (Previously Amended) The vehicle tire of claim 1, wherein said plug, o-ring or insert comprises two or more sections, wherein at least one said at least one

color; at least one scent or fragrance; at least one pheromone; at least one visual aspect; or at least one wear warning component.

**Evidence Appendix Under 41.37(c)(1)(ix)**

NONE.

There is no related evidence under 37 C.F.R. 1.130, 1.131, or 1.132 being filed with this Brief on Appeal.

**Related Proceedings Appendix Under 41.37(c)(1)(x)**

NONE.

There are no related proceedings pursuant to 41.37(c)(1)(ii).